

Application No. 10/647,9033  
Amendment dated March 9, 2005  
Reply to Office Action of October 13, 2004

### REMARKS

Applicant amended claims 1, 3, and 4 and added new claim 14 to further define Applicant's invention.

In the Office Action, the Examiner rejected claims 1-11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner contended that the terms "body" and "storage compartment" were not distinguished from one another in claim 1. Applicant amended claim 1 to recite that the body includes "a staple storage compartment." Applicant submits that the relationship between the body and the staple storage compartment is clear. Applicant further submits that the body of the claim provides support for the claim being directed to a stapler as the body of the claim recites "a staple storage compartment."

The Examiner requested Applicant to point to the figures for support for the limitation of claim 3. A copy of Fig. 8 is attached hereto as Exhibit A showing the thenar fitting concave curve (the "first" concave curve) and the second concave curve. The second concave curve extends below the thenar fitting concave curve and back towards the user. Applicant submits that the Examiner's rejection under 35 U.S.C. § 112, second paragraph has been overcome.

The Examiner rejected claims 1, 2, 5, and 6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,635,634 to Santos ("Santos"). Applicant respectfully traverses the Examiner's rejection. Santos teaches a clip applicator 10 having a handle portion 72 with a rearwardly projecting extension thereon. (Santos, col. 6, lines 36-44; Fig. 6). The rearwardly projecting extension on handle portion 72 is not proximate the juncture of the body and the handle, but is positioned nearly half-way down the height of the handle. (See Santos, Fig. 6). Moreover, a user would not be able to hold the clip applicator of Santos where the user's dorsum is in contact with the bottom surface of handle portion 72 and the index finger and the thumb of the user's hand are placed adjacent to tubular member 70 and parallel to the longitudinal axis of the tubular

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member. Santos does not teach or suggest a stapler as recited in claim 1 of Applicant's claimed invention.

The Examiner rejected claims 1, 2, and 5-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,777,948 to Wright ("Wright") or U.S. Patent No. 3,669,487 to Roberts et al. ("Roberts"). Applicant respectfully traverses the Examiner's rejection. Applicant respectfully submits that the rejection is untenable and cannot be maintained at least for the reasons stated below.

A. No motivation is used to support the rejection.

The Examiner contends that it would have been "within the purview of one having ordinary skill in the art to grasp either of the above references in the manner recited in claims 12 and 13." (Office Action, page 3, paragraph 3). This statement does not provide any motivation as to why one would grasp the handles of Wright and Roberts according to the method of claims 12 and 13. As recited in claim 12, the handle of Applicant's claimed invention is grasped by "placing the handle of the stapler in the palm of the user's hand with the thenar eminence of the palm in contact with the concave thenar fitting handle; placing the dorsum of the user's hand in contact with the bottom surface of the proximal extension; positioning the index finger and the thumb opposing one another along the body of the stapler; and placing the three remaining fingers of the user's hand around the handle of the stapler." (See MPEP § 2143.01, "the Prior Art Must Suggest the Desirability of the Claimed Invention," page 2100-129, col. 2 (May 2004)).

The Examiner further states that it "would have been [obvious] to utilize the hand-grip of Wright or Roberts et al on a stapling device." (Office Action, page 3, paragraph 3). Again, this statement does not provide any motivation as to why one of ordinary skill in the art would want to utilize the handles of either Wright or Roberts on a stapler. Accordingly, Applicant submits that the rejection is untenable and cannot be maintained.

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B. Wright and Roberts are non-analogous art.

Applicant respectfully disagrees with the Examiner's contention that the claims are not limited to a stapler. Independent claim 1, as now amended, recites a stapler having a "staple storage compartment." Independent claim 12 recites a method for grasping a stapler which explicitly recites steps in association with a stapler.

Wright is directed to a surgical ronguer. (Wright, col. 1, line 65). Roberts is directed to a tool for handling chips "normally generated by a metal-working machine." (Roberts, col. 1, lines 3-5). According to the MPEP, "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (MPEP § 2141.01(a), "To Rely On A Reference under 35 U.S.C. 103, It Must Be Analogous Prior Art," page 2100-99, col. 1 (May 2004), quoting *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992)). ("[t]he court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look, to fasteners for garments;" see MPEP 2141.01(a), "Analogy In The Mechanical Arts," page 2100-100, col. 1 (May 2004)). Neither Wright nor Roberts are directed to staplers, or are concerned with handle design problems of staplers. Accordingly, Applicant submits that Wright and Roberts are non-analogous art and cannot be relied upon to support the Examiner's rejection. Applicant submits that the rejection under 35 U.S.C. § 103(a) has been overcome.

Applicant submits that independent claims 1 and 12 are patentable and that dependent claims 2-11, 13, and 14 dependent from independent claims 1 or 12, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the

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outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1066.

Respectfully submitted,

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